REMARKS

In the Office Action that was mailed on December 4, 2003, Figures 1-3 were objected to; the Title was objected to; claims 9, 11, and 12 were objected to due to informalities; claims 1-16 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness; claims 1-4 and 7 were rejected under 35 U.S.C. § 102(e) as being anticipated by Evoy et al. (U.S. Patent No. 6,330,658) ("Evoy"); and claims 5 and 8-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Evoy in view of John L. Hennessy and David A. Patterson, Computer Organization and Design – The Hardware/Software Interface, 2nd ed., Morgan Kaufmann Publishers, p. 191, 712, and 716 (1998) ("Hennessy"). The foregoing objections and rejections are respectfully traversed.

Claims 1-16 are pending in the subject application, of which claims 1 and 9 are independent claims.

Amendments to the Specification:

The Title is amended herein. The Applicant respectfully requests that the examiner withdraw the objection thereto.

Amendments to the Claims:

Claims 1 and 9 are amended herein to change "capable of executing" to "configured to execute," to change "of or the entire" to "or entirety of the same," and to add "that the first processor executes." Claims 9, 11, and 12 are amended herein to insert the word "more" and to correct antecedent basis. Claim 11 is further amended herein to insert the word "efficient." Claims 1 and 9 are amended herein to insert the word "entire." Care has been exercised to avoid the introduction of new matter.

Amendments to the Figures:

Figures 1-3 are amended herein to be labeled as "Prior Art." The Applicant respectfully requests that the examiner withdraw the objections thereto.

Objections to the Claims:

Claims 9, 11, and 12 are amended herein, taking the examiner's comments into consideration, and directed to overcoming the objections thereto. The Applicant respectfully requests that the examiner withdraw the objections thereto.

Rejections of the Claims:

Claim Rejections Under 35 U.S.C. § 112:

In items 7-10, on pages 3-4 of the Office Action, claims 1-16 were rejected under § 112, second paragraph, for indefiniteness. Specifically, the examiner indicated that there was no antecedent basis for "the entire instruction set" in claims 1 and 9. Therefore, claims 1 and 9 have been amended herein to insert the word "entire." The Applicant respectfully requests that the examiner withdraw the rejections thereto.

Claim Rejections Under §§ 102(e) and 103(a):

In item 17, on page 7 of the Office Action, the examiner relied on both Evoy and Hennessy to reject claim 6, yet did not specify in items 12 or 20 whether claim 6 was rejected under § 102(e) or § 103(a). However, the Applicant will assume that claim 6 is rejected under § 103(a) due to the discussion of multiple references in regard thereto.

Evoy is directed to a computer system in which a slave processor is configured to process instructions of a first set, e.g., platform-independent program code such as Java, and a master processor is configured to process instructions of a second set, e.g., native program code. That is, the slave processor and the master processor are configured to process different instruction sets, i.e., different program codes. The examiner referred to column 6, lines 4-17 of Evoy, where a description is given that the control unit 52 of the slave processor executes only a portion of the Java bytecodes, and the master processor responds to an exception to handle the instructions that are not handled by the slave processor. The master processor, however, does not execute the Java bytecodes as they are, but needs a software interpreter that converts the bytecodes into native instructions on the fly. (Evoy, col. 1, lines 36-41). Accordingly, Evoy does not teach a slave processor and a master processor that execute the same instruction set.

In contrast, in independent claims 1 and 9 of the subject application (as amended

herein), the second processor is configured to execute a portion or entirety of the same instruction set that the first processor executes. Such feature is not disclosed or suggested in any of the cited references.

In addition, the examiner did not adequately support the motivation to combine Evoy and Hennessy for purposes of establishing a prima facie case of obviousness. MPEP § 706.02(j) requires that, to establish a *prima facie* case of obviousness under § 103, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure."

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "'The factual inquiry whether to combine the references must be thorough and searching.'" In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The examiner has not presented any evidence why Evoy and Hennessy would have been combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. Id. The examiner's sole support for such a combination is that Hennessy discusses connecting multiple computers to increase processing power, which would motivate someone to modify Evoy to make the second processor a

multiprocessor. The examiner cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in either reference, and the examiner has not presented any actual evidence in support of the same. Instead, the examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and must be withdrawn.

Therefore, independent claims 1 and 9 of the subject application are patentably distinguishable over the cited references. In addition, dependent claims 2-8 and 10-16 are allowable based in part on their dependency, directly or indirectly, from one of independent claims 1 and 9.

Withdrawal of the foregoing objections and rejections is respectfully requested.

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: _____

Matthew Q. Ammon
Registration No. 50,346

1201 New York Avenue, N.W., Suite 700
Washington, D.C. 20005
(202) 434-1500